

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9400-31

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on _____

Signature _____

Typed or printed name _____

Application Number

10/627,110

Filed

July 25, 2003

First Named Inventor

Harry Michael Schell

Art Unit

2176

Examiner

Laurie Anne Ries

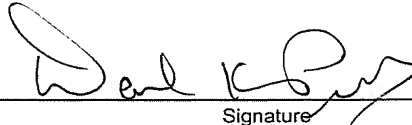
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number **40,133**☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____
Signature**David K. Purks**

Typed or printed name

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Telephone number

April 30, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Harry Michael Schell
Serial No.: 10/627,110
Filed: July 25, 2003
For: METHODS AND COMPUTER PROGRAM PRODUCTS THAT
CONDITIONALLY ROUTE PRINT FILES

Confirmation No.: 3761
Group Art Unit: 2176
Examiner: Laurie Anne Ries

April 30, 2007

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANT'S
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review that is filed concurrently herewith along with a Notice of Appeal in compliance with 37 C.F.R. 41.31. Applicant requests a Pre-Appeal Brief Review of the claims finally rejected in the Final Office Action mailed February 1, 2007 ("Final Office Action").

In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicant will only discuss the clear errors in the Final Office Action in the rejections of independent Claims 6, 16, and 21. Independent Claims 6 and 16 and dependent Claims 2-4, 7, 13-14, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2004/0001223 to Tanaka (hereinafter "Tanaka"). Independent Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Berard in view of Tanaka and Madison.

Independent Claims 6 and 16 are Patentable Over Tanaka

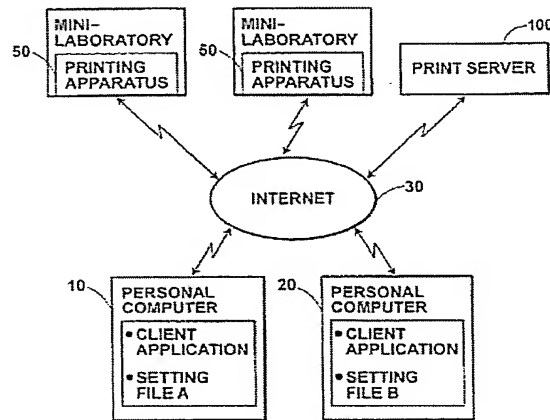
Independent Claim 6 recites (emphasis added):

6. A method of routing print files in a computer system, the method comprising:
evaluating content of at least one print file based on a routing policy, wherein the print file is configured by an application for printing on a printer device; and selectively routing the print file based on the evaluated content of the at least one print file to a non-printer device instead of to a printer device in response to the evaluated content of the print file.

Accordingly, Claim 6 recites that the file whose content is evaluated based on a routing policy is a *print file* that is configured by an application for printing on a printer device. Furthermore, the *print file* is selectively routed to a non-printer device instead of to a printer device *in response to the evaluation of the content of the print file*.

Tanaka describes a personal computer (10) that has a client application and a separate setting file (A), and another personal computer (20) that has a client application and a separate setting file (B), as shown in FIG. 1 of Tanaka below.

FIG. 1 of Tanaka



The client applications and setting files (A), (B) are installed in the personal computer (10) from media (CDs) enclosed within "as *supplements of magazines A and B*." (Tanaka, Para. 39). Tanaka describes the setting files (A),(B) as follows:

The setting files A and B attached to the client applications respectively have information representing the name of the corresponding magazine as a distribution route, the name of a privilege service available to the client application, and an effective time period of the privilege service."

(Tanaka, Para. 39).

Accordingly, the setting files (A),(B) identify from what magazine a client obtained the files (e.g., "distribution route" can be "magazine A" or "magazine B"), the type of service available to the client (e.g., "privilege service" can be the number of free print outs available), and an expiration date for the service. Tanaka illustrates the printing process by the personal computers (10),(20) and print server (100) in FIGS. 4 and 5, below.

FIG. 4 of Tanaka

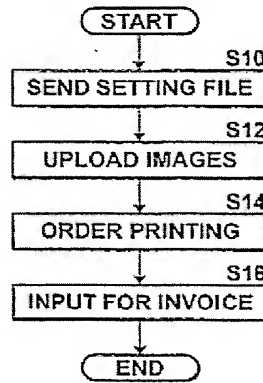
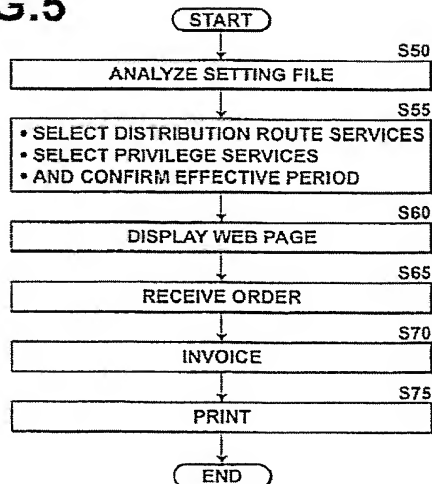


FIG. 5 of Tanaka

FIG.5



Tanaka describes that the personal computer 10 initially sends the setting file (A) (step S10) to the print server (100), where the setting file (A) defines the services that are available to the client and an expiration date for the services. The personal computer (10) then separately uploads the images (step S12) to the print server (100). *The print server (100) analyzes the setting file (step S50) and, based on the settings in the setting file, prints the uploaded images (step S75) and generates an invoice for the printing (S70).* Accordingly, the image file is a print file because it is configured by the personal computer (10) for printing (step S75) by the print server (100), while the setting file (A) is not a print file

because it is not configured to be printed and, indeed, it is not printed by the print server (100).

In sharp contrast to Claim 6, Tanaka analyzes the contents of the setting file, not the contents of the separate image file which is to be printed. Nowhere does Tanaka describe or suggest *that the contents of the image file are evaluated or, much less, that the contents of the image file are evaluated based on a routing policy.*

Moreover, Tanaka does not describe or suggest *that the image file is selectively routed to a non-printer device instead of being printed by the print server (100) in response to evaluation of the content of the image file based on a routing policy.*

For at least these reasons, Applicant submits that Claim 6 is patentable over Tanaka because Tanaka does not describe or suggest evaluating content of at least one print file based on a routing policy, and it does not describe or suggest selectively routing the print file, based on the evaluated content of the print file, to a non-printer device instead of to a printer device.

Independent Claim 16 is a computer program product claim that includes recitations that correspond to those of Claim 6 and, consequently, is submitted to be patentable over Tanaka for at least the reasons explained with regard to Claim 6.

Independent Claim 21 is Patentable Over Berard in view of Tanaka and Madison

Claim 21 recites (emphasis added):

21. A method of routing print files in a computer system, the method comprising:
searching content of a print file to identify one or more keywords that are defined by a routing policy, wherein the print file is configured by an application for printing on a printer device; and
selectively renaming the print file based on identifying the one or more keywords in the print file instead of routing the print file to a printing device.

Accordingly, Claim 21 recites that the print file is configured by an application for printing on a printing device, and that the *print file is selectively renamed based on identifying one or more keywords contained in the print file that are defined by a routing policy, instead of routing the print file to a printing device.*

In rejecting the subject matter of Claim 21, the Final Office Action on page 9 concedes that "Berard does not disclose expressly searching the content of the file to identify

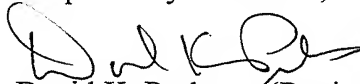
one or more keywords that are defined by a routing policy or selectively renaming the file based on the identified keywords." In the an attempt to supply some of the missing recitations, the Final Office Action contends on page 8 that "Tanaka discloses searching the content of a file to identify keywords defining a routing policy for the file." However, as explained above, Tanaka analyzes the contents of a setting file, not the contents of a separate image file that is to be printed.

The Final Office Action also contends on page 8 that "Madison discloses renaming a file based upon the data within the file, such as XML data indicating a successful or unsuccessful file upload, and a routing policy, such as the value of the XML data updated according to the result of the upload attempt." Applicant acknowledges that Madison discloses that a file is selectively renamed based on whether it was successfully upload. However, nowhere does Madison appear to disclose that the content of the uploaded file is examined or, much less, that the content of a file is searched to identify one or more keywords that are defined by a routing policy, or that the file is selectively renamed based on identifying one or more keywords via the file search.

For at least these reasons, Applicant submits that Claim 21 is patentable over Berard in view of Tanaka and Madison.

Accordingly, Applicant respectfully requests withdrawal of all rejections and the allowance of all claims in due course. In the event an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a) and any additional fees may be charged to our Deposit Account No. 50-0220.

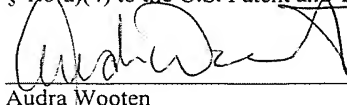
Respectfully submitted,



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USPTO Customer No. 39072

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on April 30, 2007.


Audra Wooten